

REMARKS
Applicant's Statement

Applicants have cancelled claims 1-29 and replaced them with new claims 30-59. The combustible fuel in the independent claims is now a list of specific fuels. The remaining claims as amended are then substantially identical to the claims allowed by the Examiner in the parent application now issued as U.S. Patent 6,348,074. Claims 50 to 59 are narrow ranges for specific fuels and are fully supported in the originally filed disclosure. See for example in the specification

for description and definition of fuels other than diesel fuel
at page 21, lines 17-23;
for reference to fuel to additive ratios of between 50:50 to 99:1;
at page 13, lines 31-33 through page 14, lines 1-19 - specifically line 19;
at page 15, lines 16-33 through page 16, lines 1-4 - specifically lines 12-15;
at page 17, lines 1-25, specifically line 25;
at page 32, lines 1-35, page 33, lines 1-5, specifically lines 3-5; and
at page 33, lines 7-35, page 34, lines 1-9, specifically lines 6-8.

No new matter has been added to this application.

REJECTION OF CLAIMS 1-29 UNDER 35 U.S.C. 112

Originally filed claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states that:

"Claims 1-29 are replete with indefinite and/or incorrect terms. Additionally, numerous claims fail to positively recite the components of the claimed composition. Accordingly, it is impossible to determine just what is being claimed. Specific examples are:

In claim 1, Markush groups are required to use the terminology "selected from the group consisting of". Markush groups are also to use the term "and" as opposed to "or". In a(ii), the term "by volume" is not understood. Claim 1, line 28 recites "alkyl, alkenyl or

alkynyl having between about 10 to 24 carbon atoms, with". It is unclear if the composition may contain component "d" without component "e" or if a composition containing component "d" must also contain component "e". In component "e", the recitation "wherein trialkylamines are excluded" is not understood. It is unclear how the recitation "having viscosity similar to that of the liquid combustible fuel" modifies, or is intended to modify, the recitation "where the ratio of combustible fuel:additive ranges from about 99: 1 to 0: 1 00 by volume". Especially considering that claim 1 does not contain additional "combustible fuel". Claim 1 is rendered indefinite by the recitation that the composition excludes "aromatic organic compounds" and also excludes "compounds of phenanthrene", i.e., phenanthrene is an aromatic organic compound. Claim 1 is rendered indefinite by the recitation "(e.g., alkyl or alkenyl)". Claim 1 is rendered indefinite by the recitation "other organic diacids are excluded", i.e., the claim fails to define which organic acids are excluded.

Claim 2 fails to positively recite the composition, i.e., it appears that claim 2 should be amended to recite "The additive composition of claim 1 comprising. . .". Claim 2 lacks antecedent basis to recite "the refined combustible fuel". Additionally, it is unclear how the recitation "having a viscosity similar to that of the liquid combustible fuel" modifies, or is intended to modify, the recitation "where the ratio of combustible fuel:additive ranges from about 99: 1 to 1 :99 by volume". Especially considering that claim 2 does not contain additional "combustible fuel".

Claim 3 fails to positively recite the composition, i.e., it appears that claim 3 should be amended to recite "The additive composition of claim 1 comprising. . .".

In claim 3, component "b", improperly recites "one or more alcohols selected from the group consisting of alcohols, iso-propanol and butanol". Additionally, it is unclear how the recitation "having a viscosity similar to that of the liquid combustible fuel" modifies, or is intended to modify, the recitation "where the ratio of combustible fuel:additive ranges from about 90:10 to 95:5 by volume". Especially considering that claim 3 does not contain additional "combustible fuel".

Claim 4 fails to positively recite the composition, i.e., it appears that claim 4 should be amended to recite "The additive composition of claim 1 comprising. . .".

Claim 4 is rendered indefinite by the recitation "alcohols having between about 1 and 5 carbon atoms as defined herein" (emphasis added).

Similar rejections under 35 U.S.C. §§ 112 2nd paragraph also apply to claims 5-28.

Claim 29 fails to particularly point out and distinctly claim the "soluble alcohol" used in step "a", i.e., the claim fails to define what the alcohol must be soluble with or in (e.g., diesel fuel, fatty acid, water, etc.). The "(" in the 10th line of claim 29 appears to be misplaced. The proviso that begins in the 10th line of claim 29 is confusing and renders the claim indefinite."

Applicant respectfully traverses this rejection.

Applicant has amended the claims by cancelling claims 1-29 and replacing them with newly presented claims 30 to 59. These claims recite vegetable oils as the combustible fuel source the remainder of the claims are substantially identical to the claims allowed by USPTO Examiner Jerry Johnson in the parent patent application now issued as U.S. Patent 6,348,074.

With all these amendments Applicants argue that the Examiner's concerns have been overcome and the now pending claims are now of a form and scope for allowance.

Prompt notification thereof is respectfully requested.

RESTRICTION / ELECTION

The Examiner stated that:

"Examination of this application reveals that it appears to be drawn to numerous different, distinct, and independent inventions. Because the claims are cast in such form (as discussed above) and set forth so many possible additive products and compositions containing said products, it is impossible to list all of the different, distinct, and independent inventions present.

Accordingly, at this time, restriction to one of the following inventions is required under 35 V.S.C.121:

- I. Claims 1-28, drawn to an additive composition or combustible fuel, classified in class 44, subclass 302.
- II. Claim 29, drawn to a method of determining the suitability of a composition as a useful additive to a combustible fuel to improve combustion, classified in class 44, subclass 903.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §§ 806.04, MPEP §§ 808.01). In the instant case the different inventions have different functions, i.e., claims 1-28 are directed to a composition comprising a combination of specific additives whereas claim 29 is directed to a method of determining the suitability of a composition as a useful additive to a combustible fuel and is not limited to the additive(s) of claims 1-28.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). If applicant elects claims 1-28, then further restriction and/or election may be required when the above noted indefiniteness has been overcome."

Applicants elect Claims 1-28 with traverse.

The amendments described above should overcome all of the Examiner's other concerns.

SUMMARY


Applicants assert these claims are now of a form and scope for allowance.

A petition for Extension of time for the month and a fee of \$475.00 are enclosed.

If additional fees are required for the filing of this document, the Commissioner for Patents is hereby authorized to charge or credit overpayment to Deposit Account No. 16-1331.

Respectfully submitted,

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Enclosures: 1) Petition for Extension of Time and Authorization to charge Deposit Account
16-1331 for \$475.00
2) Copy of Claims of Issued U.S. Patent 6,348,074

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